

REMARKS

- Claims **50-77** are currently pending;
- Claims **1-49** have been cancelled;
- Of the pending claims, only claims **50, 71, 72 and 74** are independent;
- Claims **50-77** are in condition for allowance.

1. Terminal Disclaimer and Double Patenting

Applicants, at the suggestion by the Examiner, previously filed a power of attorney for this application, the power of attorney naming Magdalena M. Fincham. Applicants have filed a terminal disclaimer herein, signed by Jeffrey R. Ambroziak, as a substitute for the terminal disclaimer previously submitted and not accepted. Enclosed herewith is a copy of a Power of Attorney to Prosecute Applications Before the USPTO (Form PTO/SB/80) executed by the Assignee of Record to appoint all attorneys associated with Customer No. 22,927 and granting the Power of Attorney thereto. Further enclosed is a Revocation of Prior Power(s) of Attorney, and Appoint of Power(s) of Attorney including the Statement Under 37 CFR 3.73(b) executed by Jeffrey R. Ambroziak, who is amongst the list of appointed Powers of Attorney for this case. Applicants thus respectfully request that the terminal disclaimer be accepted.

2. Claim Rejections – Section 102

Claims **50 – 54, 56 – 58, 60 – 62, 64 – 69 and 71 – 77** stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,833,537 to Barrie (“Barrie” herein).

2.1 Independent Claims 50, 71 and 74

The Examiner has reasserted, virtually verbatim, the grounds for rejection asserted in the Office Action of July 20, 2005. Applicants respectfully reassert that each of independent claims **50, 71 and 74** recite numerous limitations that are not taught or suggested by Barrie. Specifically, Barrie neither teaches nor suggests:

- *determining a number of occurrences of the at least one tracked symbol;*
- *determining whether the number is at least a minimum number;*
and
- *providing, if the number is at least a minimum number, a bonus payout.*

Specifically, Applicants reassert that Barrie does not teach or suggest any collection of symbols, much less providing a payout if a minimum number of symbols is collected. At most, Barrie teaches that a particular type of symbol may affect a payout, by affecting a magnitude of a multiplier applied to the payout.

For example, with respect to Fig. 4, Barrie describes that a multiplier symbol, if it occurs on a payline, changes the multiplier associated with the

payline: “when [a multiplier symbol occurs in a symbol position of a payline] the multiplier in the payline which contains this position 118h (in this example, the bottom payline 412c[sic] is changed to show a new value. In one embodiment, the new value will be the sum of the previous value and the value of the multiplier symbol.” Col. 6, lines 5 – 10. However, there is no teaching or disclosure in Barrie that the occurrence of such a multiplier symbol in any manner causes a bonus payout to be provided, much less the particular embodiment of determining whether to provide a bonus payout claimed in claims **50, 71 and 74** (if the number of occurrences of a tracked symbol is at least a minimum number).

In Barrie, even though a multiplier symbol occurred, no payout is provided based on the occurrence of this symbol, unless and until a winning outcome is achieved on the payline associated with the symbol. In fact, Barrie explicitly teaches away from providing any payout based solely on the occurrence (or number of occurrences) of a multiplier or other persistence symbol:

“Preferably, the symbols can affect the amount of a pay out, although preferable they do not affect whether or not a game has a winning result.” Col. 2, lines 27 – 29; and

“persistence symbols are believed to add to the action or play of the game, but do not, in themselves, occasion a pay out.” Col. 9, lines 1 – 2.

Thus, even if some number of multiplier or other persistence symbols were to be obtained by the player in Barrie, the mere occurrence of these symbols do not occasion a payout, as is claimed in claims **50, 71 and 74**. Rather, the occurrence of a multiplier or other persistence symbol in Barrie

may merely “affects the amount of the price or award, for at least some winning game outcomes.” Col. 2, lines 13 – 15. In Applicants’ claimed embodiments, once a minimum number of occurrences of at least one tracked symbol is determined, a bonus payout is provided.

In the Response to Amendment section of the Office Action (page 8), The Examiner asserted the following:

24. In regards to claims 50, 71, and 74;
 - *Determining a number of occurrences of the at least one tracked symbol*
 - *Determining whether the number is at least a minimum number;*
 - *Providing, if the number is at least a minimum number, a bonus payout.*
25. If you observe Fig. 5, Barrie’s invention tracks a symbol at #516, checks if it reaches a certain number at #518, and if it is reached it awards a bonus at #520.

Applicants respectfully assert that the Examiner is in error when interpreting and applying the teachings of Barrie. With reference to the Examiner’s citation, Barrie discloses at Fig. 5 at col. 6, lines 27-42:

FIG. 5 depicts a procedure which may be used in connection with an electronic keno game. In the embodiment of FIG. 5, after the user places a wager 512, the game selects up to 20 numbers, e.g., of a total of 80 potential numbers 514. In the embodiment of FIG. 5, a persistent symbol such as a check mark is positioned in each number location selected by the user in the previous step 516. The system then determines whether a minimum number, such as all of the symbol positions on the simulated keno card, have been filled with check marks 518, and, if so, a special prize 520, based on the presence of the persistent symbols is ordered. Otherwise, the system randomly

deletes a number of the persistent symbols 522. In one embodiment, the number which is deleted on each turn is a constant. In another embodiment, the deleted number may vary from round to round. Preferably, the number deleted is, at least on average, low enough to permit a determined player to eventually win the prize 520, but large enough to require players, in most cases, to play a relatively large number of rounds in order to have a reasonable chance of winning the prize 520. In one embodiment, two to three symbols are deleted each round. As before, the device may be provided with animation 524, in conjunction with the persistence features of the game.

Applicants note that this description contains numerous logical inconsistencies that render a clear understanding of the teaching unobtainable. Attempts by the Applicants to obtain an explanation of the Examiner's understanding of this citation via a phone interview were denied. Specifically, the Examiner declined to grant an interview unless and until the Applicants agreed, a priori and absent the sought clarifying explanation, to provide proposed amendments to the pending claims.

Put, simply, the disclosure is both unclear and logically inconsistent. In addition, the Examiner's perception of the teachings of Barrie, while perhaps superficially plausible, suffers of necessity from the underlying defects in the disclosure of Barrie.

Applicants proceed by providing a brief explanation of the defects of Barrie. The method steps of Fig. 5 are annotated as follows: "wager" (step 512), "select 20 numbers" (step 514), and "add persistence symbols to selected numbers" (step 516). It is therefore evident that the selected numbers of step 516 are the 20 numbers selected in step 514. Further support for this observation is provided in the citation above wherein it is stated that "the game selects up to 20 numbers, e.g., of a total of 80 potential

numbers 514”. It is therefore evident that the selected 20 numbers are selected by the game.

A problem therefore arises when Barrie discloses that “In the embodiment of FIG. 5, a persistent symbol such as a check mark is positioned in each number location **selected by the user in the previous step 516.**” (emphasis added). The number locations, more accurately “the numbers”, selected in the immediately preceding step are not selected by the user, but rather by the game. The only other preceding step, step 512, contains no annotation indicating any selection of numbers by the player. It is therefore not clear whether the check marks are positioned at the number locations selected by the game or at some other undefined positions corresponding to numbers selected by the player. Assuming, arguendo, that the check marks are related to some selection by the user/player, it is clearly stated that the check mark **is** the persistent symbol and it is positioned in a number location selected by the user. Therefore, the location of each check mark is the symbol position.

All of this leads to the confusing disclosure that “The system then determines whether a minimum number, such as all of the symbol positions on the simulated keno card, have been filled with check marks 518”. Of the two possible interpretations of this teaching, neither appears logical. As noted above, the symbol positions are defined to be some manner of position in which a check mark (the symbol) is positioned. In short, no check mark, no symbol position. Therefore, by definition, at all times, each and every symbol position is filled by a check mark. As the number of check marks is greatest (in fact it is at a maximum) prior to the subsequent deletion of any check marks, a special prize would be awarded at the outset of any game, regardless of any possible set minimum number of check marks. And yet,

Barrie clearly contemplates, as noted in the recitation above, that the user does not win the prize every game. It is therefore clear that, contrary to the clear teachings of Barrie, the disclosed symbol positions differ from the positions of the check marks

If one assumes, alternatively, that the symbol positions refer to all of the *potential* symbol positions on “the simulated keno card” (nowhere described or illustrated), other problems of interpretation arise. Consider once again that Barrie states that “The system then determines whether a minimum number, such as all of the symbol positions on the simulated keno card, have been filled with check marks 518”. As written, the exemplary “minimum number” is “all of the symbol positions”, presumably the total number of such positions, of the keno card. However, this number cannot serve as a minimum as the number of check marks is presumably always less than the “total of 80 potential numbers 514”. In short, if 80 keno card positions is the minimum number of positions that must be filled by user selected check mark positions in order to win the prize, the player can only win if he/she selects every position. However, were this allowed, the player would win every time at the outset when the number of check marks equals the minimum, 80. Such is not the case.

With an understanding of these various internal inconsistencies, Applicants respectfully turn to the Examiner’s interpretation of the teachings of Barrie. As noted above, the Examiner asserted that “If you observe Fig. 5, Barrie’s invention tracks a symbol at #516, checks if it reaches a certain number at #518, and if it is reached it awards a bonus at #520.”

Applicants respectfully assert that, contrary to the Examiner’s assertion, Barrie does not teach *determining a number of occurrences of the*

at least one tracked symbol, determining whether the number is at least a minimum number, and providing, if the number is at least a minimum number, a bonus payout as claimed.

When the Examiner's assertions are aligned with the claimed elements and interpreted in light of the discussion above, it is evident that Barrie fails to teach or otherwise suggest the elements of claim **50**. The Examiner appears to equate the "symbol at #516" with the claimed "at least one tracked symbol". Note that claim **50** further recites determining a number of occurrences of the tracked symbol and determining if such a number is equivalent to a minimum number. The Examiner continues by asserting that Barrie checks if it (the tracked symbol) reaches a certain number at #518. Presumably, the Examiner is inferring that Barrie keeps track of the number of check marks and checks to see if this number "reaches a certain number #518". However, as described above, there is no reasonable and logically consistent interpretation of Barrie that involves providing a bonus payout when the number of check marks reaches a minimum. As noted above, regardless of the conflicting assumptions under which one proceeds to interpret the teachings of Barrie, it is clear that the number of check marks is at a maximum at the commencement of the game, that the number of check marks decreases over time, and that it is this decreasing number that triggers a payout when it equals some minimum number. As the number of check marks cannot *decrease* to reach such a minimum, Barrie clearly involves some aspect or attribute of the check marks separate from the check marks, and not identified or disclosed, that causes the bonus prize to be paid.

While the Applicants are unable to propose even a guess as to what this attribute might be, it is clear that, contrary to the Examiner's assertions, Barrie fails to teach *determining a number of occurrences of the at least one*

tracked symbol, determining whether the number is at least a minimum number, and providing, if the number is at least a minimum number, a bonus payout as recited in claim **50**. For all of these reasons, claim **50** is in condition for allowance. As both of claims **71 and 74** recite similar language, they are likewise in condition for allowance.

2.2 Independent Claim 72

The Examiner reasserted, verbatim, the grounds for rejection of claim 72 asserted in the Office Action of July 20, 2005. Applicants respectfully reassert that independent claims **72** recites numerous limitations that are not taught or suggested by Barrie. Specifically, Barrie neither teaches nor suggests:

- *determining a count value wherein the count value is incremented when there is an occurrence of the at least one tracked symbol and the count value is decremented when an occurrence of the at least one tracked symbol expires, such that the count value may be a non-zero integer after the count value is decremented upon an expiration of an occurrence.*

Applicants respectfully reassert that Barrie does not teach or suggest any collection of symbols, much less providing a payout if a minimum number of symbols are collected. At most, Barrie teaches that a particular type of symbol may affect a payout, by affecting a magnitude of a multiplier applied to the payout.

In the Response to Amendment section of the Office Action (page 9), The Examiner asserted the following:

29. Barrie's invention states in the description of Fig. 3 (Col 5:27-52), incrementing the count, decrementing the count and expiration limits, combined with the description of Fig. 5 (Col 6:27-50), covers this argument.

Applicants respectfully assert that the Examiner is in error when interpreting and applying the teachings of Barrie. Specifically, Applicants respectfully assert that Barrie does not teach, at the Examiner's citation or elsewhere, incrementing a count value of the occurrences of a tracked symbol and decreasing the count value when the occurrence of the tracked value expires.

Barrie teaches, at the Examiner's citation to Col. 5:27-52:

As depicted in FIG. 3, the game is initiated when a player places a wager 312 and initiates a spin 314 (or, in the case of keno game, a number draw; in the case of a card game, a deal, etc.). After the spin, it is determined whether an add event has occurred 316. In the embodiment of FIG. 1, an add event is the appearance of a red ball. A number of types of add events can be used for the present invention. For example, a persistent symbol can be added in response to the passage of a certain amount of time or play of a certain number of rounds, without the appearance of the persistent symbol in a given position. Persistent symbols can be randomly generated, e.g., by events output from a random number generator, and the like. If an add event has occurred, the persistent indicator is shown on the play field 318. The system also determines whether a delete event has occurred 320. In the embodiment of FIG. 1, a delete event is the appearance of a black ball in a location which bears a persistent symbol. Other types of delete events can be used, such as the passage of a certain amount of time or play of a certain number of games, a period of time without any game

play, a new player initiating play on the gaming terminal (as might be indicated by a player card inserted in the card acceptor), and the like. If desired, the frequency of adding and/or deleting events may be dynamic, such as changing the frequency at various times of day, or in other fashions, e.g., for marketing purposes and the like.

As is evident, Barrie teaches adding a persistent symbol in response to an add event and deleting a persistent symbol in response to a delete event. There is no teaching of, and indeed no need for, a counter of any sort tracking the occurrences and expirations of a tracked symbol as claimed. Applicants therefore respectfully assert that the Examiner is in error when asserting that Barrie “state in the description ... incrementing the count, decrementing the count and expiration limits”. Further, as there is no teaching of the claimed count value, the Examiner is further in error when asserting that a combination of the above citation with that of Col. 6:27-50 “covers this argument”.

Applicants do note that Barrie teaches, at col. 5, lines 8-18:

In an embodiment in which it is desired to retain a persistent position for no more than five successive rounds, the system can be configured such that a value of zero in a memory location means that no persistent symbol is to be displayed in the corresponding play field position, and such that a value of five is stored in the corresponding memory location whenever a persistent symbol is first positioned at a location of the play field. Thereafter, each time a round is played, the values of all non-zero, positive memory locations in the array 234 may be decremented by one. In this fashion, a persistent symbol will be removed after five games.

It is evident from this passage that Barrie teaches incrementing and decrementing a value in memory corresponding to a persistence value of a

persistent symbol. However, this value is not a count of the occurrences of a tracked symbol, nor is it *decremented when an occurrence of the at least one tracked symbol expires* as claimed. Rather, it is by decrementing the value in memory that a tracked symbol of Barrie ceases to persist and, hence, expires.

It is therefore evident that Barrie fails to teach or otherwise suggest *determining a count value wherein the count value is incremented when there is an occurrence of the at least one tracked symbol and the count value is decremented when an occurrence of the at least one tracked symbol expires, such that the count value may be a non-zero integer after the count value is decremented upon an expiration of an occurrence* as recited in claim 72. For this reason alone, claim 72 is in condition for allowance.

It is respectfully submitted that each of dependent claims **51 – 54, 56 – 58, 60 – 62, 64 – 69 and 73, and 75 – 77** is patentable at least for the same reasons as claims **50, 71, 72 and 74** (i.e., because each of these independent claims include one of the sets of features discussed above).

3. Claim Rejections - Section 103

Claims **55, 59 and 63** stand rejected under 35 U.S.C. §103(a) as being unpatentable over Barrie in view of U.S. Patent No. 6,165,071 to Weiss. Claim **70** stands rejected under 35 U.S.C. §103(a) over Barrie. The Examiner has reasserted, verbatim, the grounds for rejection of asserted in the Office Action of July 20, 2005. Applicants respectfully reassert that Weiss, like Barrie, fails to teach or suggest the feature of providing a bonus payout if it is determined that a number of occurrences of a tracked symbol

is at least equal to (or exceeds) a minimum number or bonus value and that, as a result, claims **55, 59, 63 and 70** are in condition for allowance.

Further, Applicants respectfully reassert that no proper motivation to modify the reference has been provided. The stated motivations are merely statements of asserted advantages that may be realized from the proposed motivations. The motivations do not appear as objective teachings in the record that would have motivated one of ordinary skill in the art to make the proposed modifications, as is required.

In the Response to Amendment section of the Office Action (page 9), the Examiner asserted the following:

31. In regards to claims 55, 59, and 63, stands rejected under the same references, since the argument about a payout after a tracked symbol reaches a specific number is easily seen in Barrie's Fig 5 and expressed in the description of Fig. 5 (Col 6:27-50)."

Applicants respectfully assert that the "argument about a payout after a tracked symbol reaches a specific number" is in fact not seen, easily or otherwise, "in the description of Fig. 5 (Col 6:27-50)" or elsewhere. Applicants respectfully refer to the detailed discussion of this assertion above (section 2.1) with reference to claims **50, 71 and 74**. For all of the reasons discussed above, claims **55, 59 and 63** are in condition for allowance.

In the Response to Amendment section of the Office Action (page 9), the Examiner further asserted the following:

32. The applicant also states that no motivation to modify the reference has been provided, but fails to specifically show where the examiners motivation statements fails to comply with 35 U.S.C. 103(a).

Applicants respectfully note that it is well settled that “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). Furthermore, the teaching, suggestion, or motivation must be found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

When rejecting claims **55, 59, and 63**, the Examiner asserted that “It would have been obvious to one of ordinary skill in the art at the time of the invention to have to have incorporated the continued play incentive program including the portions described above into the system/method of Barrie in order to encourage continued play among player’s”. (Office Action, page 7, section 20).

The Examiner cites no teaching, suggestion, or motivation found either explicitly or implicitly in the references as proper motivation for combining the references. Furthermore, the Examiner provides no evidence that a motivation to combine the references can

be found in knowledge generally available to one of ordinary skill in the art at the time of the invention. As a result, the Examiner has failed to establish a prima facie argument of obviousness with regards to claims **55, 59, and 63**. For this reason alone, claims **55, 59, and 63** are in condition for allowance.

Conclusion

For the foregoing reasons it is submitted that all of claims **50-77** are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Jeffrey Ambroziak at telephone number (203) 461-7317 or via electronic mail at jambroziak@walkerdigital.com.

Applicants include herein a petition for a two month extension of time. If any additional fees should be necessary for the present Application at this time (or any time during the prosecution of the present Application), please charge any such required fee to our Deposit Account No. 50-0271. Please credit any overpayment to Deposit Account No. 50-0271.

Respectfully submitted,

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Date

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